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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/467,221	12/20/1999	TAKUMI OKAUE	450100-4465.	2064

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[REDACTED] EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
	2876

DATE MAILED: 09/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/467,221	OKAUE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Ahshik Kim	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 18 June 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 19-24 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 19-24 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Response***

1. Receipt is acknowledged of the response filed on June 18, 2003. Claims 19-24 remain  
5 for examination.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

10        A person shall be entitled to a patent unless –  
  
15        (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 19 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsuo et al. (US 5,974,513).

20        Matsuo teaches an IC memory card 100 interfacing with an external device – reader/writer 200 (col. 3, lines 10+; col. 2, lines 7+) via various terminals 1a-1e. In one embodiment, memory for data storage can be a flash memory (col. 9, line 63 – col. 10, line 10). In controlling reading/writing of the memory, many switches such as 311 and read-write inhibit flag are used to verify location of address and password stored therein (col. 3, lines 53+). As  
25 further shown in figure 5, only after read-write inhibit state is released (see figure 5, col. 5, lines 51+), read/write operation is performed in accordance with the external interface.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later 15 invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20 5. Claims 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo et al. (US 5,974,513) in view of Robinson (US 5,388,248). The teachings of Matsuo have been discussed above.

Although Matsuo discloses various connectors 1a-1e, Matsuo fails to specifically teach or fairly suggest that the interface includes nine connectors at least one of which transmits and receives data.

25 Robinson teaches a memory card 110 for storing data from an external apparatus 101 (col. 1, lines 26+; figure 2). Robinson further discloses the interface within the card includes

nine connectors at least one of which transmits and receives data (figure 3, and col. 6, lines 27-34).

In view of teachings disclosed by Matsuo and Robinson, it is the Examiner's view that number of connectors used in the interface can be considered a design variation element. For example, if the address location increases (i.e., memory for the data storage is increased), more connectors are required to locate all memory locations. Accordingly, number of connectors can be increased or decreased depending on the capacity of the memory.

10 6. Claims 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo et al. (US 5,974,513) in view of Jigour et al. (US 5,815,436). The teachings of Matsuo have been discussed above.

Matsuo fails to teach the memory card wherein the data is received from and transmitted to the external apparatus in serial form.

15 Jigour teaches memory cards (figure 23) wherein the data can be received from and transmitted to the external apparatus in parallel and/or serial form (col. 18, lines 38-53). Serial form of transmitting/receiving data is conventional in the art for cheaply transferring digital information one bit at a time in the order the values were stored during the initial entry. It would have been obvious to one of ordinary skill in the art of normal engineering practices to employ a 20 device to receive data from and transmitted data to the external apparatus in serial form, as is taught by Jigour, in order to maintain low cost of data transfer between the memory card and the external device. Thus such a modification would have been an obvious expedient.

***Response to Arguments***

7. The Applicants' arguments filed on June 18, 2003 have been carefully considered, and but they are not persuasive for the following reasons.

In the remarks, the Applicants argued that the Matsuo patent does not teach "a switch settable to a state which inhibits writing data into said flash memory" (page 2, 2<sup>nd</sup> paragraph thereafter). The Applicants further pointed out that one of the gates 311 cited in previous office action is not a switch recited in claim 19.

Examiner respectfully disagrees with the Applicant's assertion because the gates disclosed in the Matsuo patent clearly functions as a switch (see figure 5, block S52; col. 5, lines 10 51+). Without delving into the related references, it is the Examiners' position that "switch" and "gate" can be broadly interpreted as equivalent device in logic circuitry. Both take some input values and generate output.

In the Matsuo reference, the state for the memory is initially set to "inhibit state". After verification of password, the "inhibit state" is released to a state allowing read and write 15 operation. In order to retain "inhibit state" or "enabled state", there exists a device (a gate, a register or a switch) which transmit the state information to the reader/writer so that the reader/writer can perform input or output operation.

With respect to "control means", as shown in figure 1, the memory card 100 is comprised of a connector portion 1, a semiconductor memory 2, a memory control portion 3, a password 20 portion 4, and password address comparison portions (see figure 1; col. 3, lines 10+). When an instruction is received from the reader/writer 200, the device performs one embodiment illustrated in figure 5. It is inherent that the device is equipped with a processing unit for

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controlling various components and processes performed within each component parts (see claim 1, “..... memory control means .....”). The memory control means does not perform such functions arbitrarily. Rather they are executed in accordance with the instructions when they the instructions are received from the reader/writer (col. 5, lines 51+).

5       Regarding dependent claims (20, 21, 23 and 24), the Applicants rely on the argument that Matsuo reference does not teach the claimed subject matter in claims 19 and 22. Therefore, the dependent claims are not taught by the combined references to Matsuo in view of Robinson/Jigour. As described above, it is the Examiner’s position that the Matsuo patent read on claims 19, and 22. Accordingly, the subject matter recited in dependent claims are also taught  
10      by Matsuo in view of Robinson/Jigour.

Applicants’ remarks have been carefully reviewed and considered. However, the cited references still teach the subject matter claimed in the instant application, and therefore, the Examiner has made this Office Action final.

15

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO  
20      MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5 Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

15 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

20 All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

25

  
Ahshik Kim  
Patent Examiner  
Art Unit 2876  
September 10, 2003

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